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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/991,880 | 11/26/2001 | Yoshiaki Nanko | SN-US015166 | 3242 |

22919 7590 11/26/2004

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| EXAMINER |
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MCANULTY, TIMOTHY P

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| ART UNIT | PAPER NUMBER |
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3682

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,880

Applicant(s)

NANKO, YOSHIAKI

Examiner

Timothy P McAnulty

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,9-12,15,16, and 18-21 is/are allowed.
- 6) ☒ Claim(s) 2-8,13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 2-8, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,099,425 to Kondo (Kondo '425) in view of US Patent No. 3,730,012 to Juy (Juy '012).

Kondo '425 discloses in figure 4, a front derailleur for a bicycle comprising a fixed member 30 having a curved mounting portion coupled to a frame having a first mounting flange 50 and a second mounting flange 52 spaced apart from said first mounting flange; a chain guide 32 having first and second support flanges spaced apart by a distance substantially equal to a distance between said first and second mounting flanges; a linkage assembly having a first link 81 having a cable attachment portion 22 coupled to said fixed member at a first pivot point defining a first pivot axis, a second link 43 coupled to said first and second mounting flanges defining a second pivot axis passing through said first and second mounting flanges, said second link being pivotally coupled to said first and second support flanges, and a biasing member 35; wherein said first pivot axis is substantially coincident with a center plane of said frame that extends substantially parallel to said first pivot axis; wherein said first mounting flange is located on a first side of a plane which passes through a center of said curved mounting portion and is perpendicular to said second pivot axis; and wherein said second mounting flange is located on a second side of said plane opposite said first mounting flange. Kondo '425 does not disclose said first and second mounting flanges having different axial widths as measured along said second pivot axis. However, Juy '012 teaches in figure 2 a front derailleur comprising, *inter alia*, a first

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mounting flange and a second mounting flange having different axial widths. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Kondo '425 in view of the teachings of Juy '012 to provide said first and second mounting flanges with different axial widths so as to increase the strength of one of said flanges relative to the other of said flanges.

Regarding claims 3-8 and 13, the reference combination previously set forth does not disclose the specific dimensional relationships as claimed of the elements. However, the actual dimension is merely a matter of engineering design choice and the level of skill of one of ordinary skill in the art would produce a similar optimization, especially lacking any evidence to the contrary, i.e., unexpected results.

Furthermore, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 10 USPQ 233 (CCPA 1955).

Allowable Subject Matter

3. Claims 1,9-12,15,16, and 18-21 are allowed.

Regarding claims 1,11,12,16,18, and 19, the prior art discloses or teaches the basic apparatus as previously set forth, however, the prior art does not disclose or teach providing a majority of the larger mounting flange outside the mounting area defined by the front and rear planes. The combination of Kondo '425 in view of Juy '012 makes obvious the modification to provide a first mounting flange larger than a second mounting flange, wherein the first mounting flanges is located outside of a similarly defined mounting area. Modifying the first flange to be larger, however, will not necessarily provide the first flange to be majorily outside of the

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mounting area; i.e., the first flange could be modified to be larger either into or out of the mounting area with no specific teaching to make one modification over the other but could not be further modified to be specifically located without a specific teaching. The non-obviousness is further evidenced by the teachings of Juy '012 that show the larger flange to be within the mounting area.

Regarding claims 9,10,15,20, and 21, reasons for allowance have been previously set forth in prior Office actions.

Response to Arguments

4. Applicant's arguments filed 10 November 2004 have been fully considered but they are not completely persuasive.

Applicant's arguments with respect to 35 USC §112 rejections of independent claim 1 and the dependent claims thereof are persuasive. The specification fully supports the claim limitations as to the dimensional relationships of the first and second flanges and the curved mounting surface (front and rear planes). The drawings sufficiently show the dimensional relationship and the amendments to the specification alleviate any conflicting preferred dimensions.

Regarding claims 2-8, 13, and 17, the reference combination of Kondo '425 in view of Juy '012 meets all of the claimed limitations. Namely, in figure 4 of Kondo '425 the first and second support flanges of the chain guide are spaced apart and connected to tabs on the second link, wherein said tabs on said second link are spaced apart by a distance substantially equal to the distance between said first and second mounting flanges. That is, the second link pivotally

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couples the chain guide to the first and second mounting flanges and has an constant width substantially equal to the distance between said first and second mounting flanges.

Furthermore, the deficiencies of Juy '012 as to not fairly suggesting a second link pivotally coupled to said first and second mounting flanges is irrelevant to the teachings of Juy '012 showing two mounting flanges having different axial widths. The teachings of Juy '012 are relied upon to modify the apparatus of Kondo '425, not vice versa, and such a modification would have been obvious to one of ordinary skill in the art at the time the invention was made; the apparatus of Kondo '425 would not be destroyed when modified by the teachings of Juy '012.

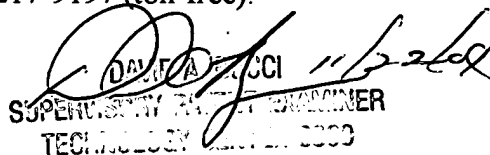
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tpm



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